

Claims 11- 19 are pending. Claims 11-12 and 14 were rejected under 35 U.S.C. § 102(e) as being anticipated by the patent to Futami (GB 2308775A).

Claims 13 and 15 – 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Futami and unspecified art officially noticed by the Examiner.

Claims 17 – 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Futami, Benedetto et al (U.S. Patent No. 4,591,661), and unspecified art officially noticed by the Examiner.

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Futami, Chin (U.S. Patent No. 5,661,788), Kitamura (U.S. Patent No. 5,987,106) and unspecified art officially noticed by the Examiner.

(4) STATUS OF AMENDMENTS

All amendments have been entered. No amendments were made subsequent to the Examiner's final rejection.

(5) SUMMARY OF INVENTION

The present invention relates to a cellular telephone with storage and playback features for audio and video files. The cellular telephone comprises a transceiver for transmitting and receiving audio and data signals, and a microprocessor for controlling the operation of the transceiver. A signal processing circuit operatively connects the transceiver and microprocessor for processing signals transmitted and received by the transceiver. An entertainment module having a computer memory connects to the microprocessor and signal processing circuits. The entertainment module stores audio and video in "memory" for subsequent playback under the control of the microprocessor.

The application explicitly defines the term “memory” to mean all forms of computer memory but excludes disk storage, tape storage, and other memory devices requiring electromechanical read systems. The memory may, for example, be in the form of a removable ROM cartridge and/or an expansion RAM. In those embodiments having an expansion RAM, an input port is provided for loading music or other audio signals into memory from a CD player, computer, or other source of digitized audio (specification page 3, lines 1-6).

(6) ISSUES

- a) Whether claims 11-12 and 14 are anticipated by Futami?
- b) Whether the Examiner established a *prima facie* case of obviousness with respect to claims 13 and 15-19?

(7) GROUPING OF CLAIMS

Claims 11-12 and 14 stand or fall together.

Claims 13 and 15-19 stand or fall together.

(8) ARGUMENT

A. Claim Interpretation Principles

It is well-settled that a patentee may be his or her own lexicographer. *Hormone Research Foundation Inc. v. Genetech Inc.*, 15 U.S.P.Q.2d 1039 (Fed. Cir. 1990); *Manual of Patent Examining Procedure*, §211.01. The ability to define the terms used in the claims is necessary so that the Applicant can carefully define the metes and bounds of the claims. The ability to define claim terms is particularly important when the words commonly used to describe an element of the invention are susceptible to more than one interpretation. See, *In re Paulsen*, 31 U.S.P.Q.2d 1671, 1674 (Fed. Cir. 1994)(noting that term “computer” is susceptible to more than one interpretation).

It is also well-settled that, during prosecution of a patent application, claims are given their broadest reasonable interpretation consistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 U.S.P.Q. 2d 1320, 1322 (Fed.Cir. 1989). This means that the words of a claim are given their broadest plain meaning unless the applicant has provided a clear definition in the patent specification. *MPEP*, § 2111.01. “When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant’s invention and its relation to the prior art.”, *MPEP*, § 2173.05(a).

B. Claims 11-12 and 14 Are Not Anticipated By Futami

The Examiner’s rejections of claims 11-12 and 14 are based on an erroneous interpretation of the term “memory.” The patent specification provides a clear and unequivocal definition of the term “memory.” Specifically, the term “memory” is defined in the specification to mean “all forms of computer memory but [does] not include disk storage, tape storage or other memory requiring electromechanical read systems.” Specification, p. 3, lines 1-2. At the time the application was filed, Applicant was aware that the term memory was capable of more than one interpretation. To avoid confusion over the meaning of the claims, Applicant provided an explicit definition of the term “memory.” This definition indicates Applicant intent to limit the term “memory” to devices that do not require electromechanical read systems.

When properly construed, claim 11 is not anticipated by Futami because Futami fails to disclose a cellular phone with a “memory” to store and playback audio and video files. Instead, Futami discloses a cellular phone with a CD-ROM drive to play audio stored on a disk. However, the term “memory” as defined in the specification excludes electromechanical memory

devices, such as CD-ROM drives. Since a CD-ROM drive is not a “memory” as defined by the specification, claim 11 is not anticipated.

In rejecting claim 11, the Examiner completely ignores Applicant’s explicit definition of the term “memory” in the specification and, instead, resorts to a technical dictionary to ascertain the “accepted meaning” of the term. The Examiner then argues that the ordinary meaning of the term “memory” as broadly interpreted by the Examiner covers a CD-ROM drive and that Futami therefore anticipates claim 11.

In general, resort to a technical dictionary to ascertain the accepted meaning of a term is proper when the Applicant has not provided a definition of a claim term. But when the claim term is explicitly defined in the specification, the applicant’s definition must be applied unless the applicant’s definition is repugnant to the accepted meaning of the term. *MPEP*, § 2173.05(a). The Examiner erred by using a broad definition of “memory” rather than the narrower definition contained in the patent specification.

The circumstances of this case are similar to the circumstances presented in *In re Paulsen*, 31 U.S.P.Q.2d 1671, 1674 (Fed. Cir. 1994). In *Paulsen*, the Court was attempting to determine the meaning of the claim term “computer”. The Court recognized that the term “computer” was susceptible to more than one interpretation. In *Paulsen*, the Court states:

[t]he term ‘computer’ is not associated with any one fixed or rigid meaning, as confirmed by the fact that it is subject to numerous definitions and is used to describe a variety of devices with varying degrees of sophistication and complexity.

Id. The Court noted the long established practice of giving claim terms their ordinary and accustomed meaning, “unless it appears from the specification or the file history that they were used differently by the inventor.” *Id.* Although, the Court searched for an indication of a more specialized definition, the broad meaning of the term was applied in that case because the

Applicant failed to define the disputed term in the specification. The Court indicates, however, that a more restrictive definition would be applied if the disputed term had been defined with “clarity, deliberateness, and precision” in the specification. *Id.*

As with the word “computer” in *Paulsen*, the term “memory” can have more than one meaning. In a broad sense, “memory” could mean any device capable of storing data. But the term “memory” is also frequently used in a narrower sense to mean chip memory or solid state memory, such as RAM and ROM. For example, when a computer maker advertises a computer with 32 MBs of memory, the term memory does not refer to the CD-ROM drive or even the storage capacity of the hard drive. In this context, memory means chip memory.

In the present case, the Applicant provided a clear and unambiguous definition in the specification of the term “memory,” which excludes electromechanical memory devices such as tape drives, hard disks and CD-ROM drives. The Applicant’s use of the term “memory” is not repugnant to the ordinary meaning of the term, but instead was crafted to limit the scope of the term “memory” to a subset of memory devices.

The Examiner failed to recognize that the term “memory” can have more than one meaning, which is the reason Applicant defined the term in the patent specification. Applicant’s definition is not repugnant to the accepted meaning of the term, but instead merely restricts the usual meaning of the term to a subset of memory devices.

The Examiner erred by refusing to apply the express definition of “memory” contained in the specification. Accordingly, the Examiner’s rejection of claims 11-12 and 14 should be reversed.

C. The Examiner Failed to Establish *Prima Facie* Obviousness of Claims 13 and 15-19.

The rejections of claims 13 and 15-19 under 35 U.S.C. § 103 should also be reversed since the Examiner's rejection of those claims is likewise based on an erroneous definition of the term "memory." None of the references relied upon by the Examiner teach a "memory" as defined in the specification. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness.

Conclusion

Because the Examiner failed to properly construe the term "memory," the Examiner's rejections of claims 11-19 should be reversed.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

By:



David E. Bennett

Registration No. 32,194

P.O. Box 5

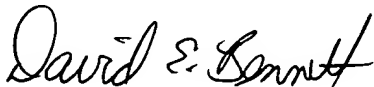
Raleigh, NC 27602

Telephone: (919) 854-1844

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(9) APPENDIX

Claims

11. A cellular telephone having an entertainment module for playing pre-recorded audio and video signals comprising:
 - a. a transceiver for transmitting and receiving audio and data signals;
 - b. a microprocessor for controlling the operation of said transceiver;
 - c. a signal processing circuit operatively connected to the transceiver and microprocessor for processing signals transmitted and received by the transceiver;
and
 - d. an entertainment module with a computer memory operatively connected to the microprocessor and signal processing circuits for storing audio and video signals for subsequent playback under the control of said microprocessor.
12. The cellular telephone of claim 11 wherein said memory comprises an erasable and programmable memory for storing and playing audio and video signals.
13. The cellular telephone of claim 12 including an input coupled to the erasable and programmable memory for downloading and storing audio and video signals into said erasable and programmable memory.
14. The cellular telephone of claim 11 wherein said memory comprises a permanent memory which is removable from said cellular telephone for storing and playing audio and video signals.

15. The cellular telephone of claim 11 wherein the entertainment module includes a first memory which is programmable and erasable, an input coupled to said first memory for downloading and storing audio and video signals into said first memory, and a second permanent memory having pre-recorded audio and video signals stored therein.

16. The cellular telephone according to claim 15 wherein said second memory is a removable and interchangeable memory cartridge.

17. The cellular telephone of claim 12 wherein said erasable and programmable memory is coupled to a headset port in the cellular telephone, thereby permitting audio signals to be directed from the memories to a headset coupled to the cellular telephone via the headset port.

18. The cellular telephone of claim 12 wherein the microprocessor is pre-programmed to preempt output from said erasable and programmable memory in response to an incoming call or the initiation of an outgoing call.

19. The cellular telephone of claim 12 further including a screening memory in communication with said microprocessor for storing a list of preferred callers and wherein said output from said erasable and programmable memory is not preempted in response to an incoming call unless said incoming call is from a caller on said list of preferred callers.